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EXAMINER

AKERS, G

ART UNIT	PAPER NUMBER
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2164

DATE MAILED:

05/16/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/353,896

Applicant(s)
Estes et al

Examiner
Geoffrey Akers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 3, 2001
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, and 4-16 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, and 4-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 20) ☐ Other: _____

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DETAILED ACTION

Response to Amendment

1. The text of those sections of Title 35 US Code not included in this action can be found in a prior Office action(See Serial No:09/353,896). The text of those sections of Title 35, US Code not otherwise provided in a prior Office action will be included in this action where appropriate.
2. This action is responsive to the amendment filed 4/3/01.
3. Claim 3 was cancelled by applicant; claims 1,5,6,8,10,11 were amended; no new claims were added. Claims 1-2 and 4-16 are pending.

Claim Rejections - 35 USC § 102

4. The following is a quotation of 35 U.S.C. 102 which forms the basis for all obviousness rejections set forth in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-2 and 4-16 are rejected under 35 USC 102(b) as anticipated by Gifford et al(US Pat. No: 5,724,424). The rejections cited in the First Action are maintained.
6. (AMENDED) As per claim 1 Gifford teaches a machine-based method comprising analyzing an e-mail message to derive response information concerning a commercial transaction(col 5 lines 49-60)(Fig 6/19/20/21/23/25), the e-mail message comprising at least part of an e-mail message sent to a customer and a response of a customer to the e-mail and based on the derived

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information, and automatically generating commercial transaction data in a format that is usable to automatically complete the commercial transaction.

7. As per claim 2 Gifford teaches the method of claim 1 in which the commercial transaction comprises an order for a product or service(col 4 line 51-53).

8. As per claim 3 Gifford teaches the method of claim 1 in which the e-mail message comprises at least part of an e-mail sent to a customer and responses of the customer to the e-mail(col 5 lines 49-60).

9. As per claim 4, Gifford teaches the method of claim 1 in which the automatic completion of the commercial transaction comprises order fulfillment(Fig 3/5/6/7)(col 5 lines 24-29).

10. (AMENDED) As per claim 5 Gifford teaches a machine-based method comprising sending an e-mail message to a customer offering a product or service for sale(col 5 lines 18-19), the e-mail message comprising locations for response by the customer indicating his intention to order the product or service(Fig 3/5-6-7)(col 5 lines 24-26),receiving from the customer an e-mail message that includes the response, based on the received e-mail message, automatically generating order information in a format usable automatically by an order fulfillment system to cause the order to be filled(Fig 4/15)(col 5 lines 34-37)(Fig 5/18).

11. As per claim 6, Gifford teaches a machine-based method comprising analyzing an e-mail message to derive response information concerning a commercial transaction(col 5 lines 49-57)(Fig 6/19/20), automatically identifying response information which requires resolution of an

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issue with the source of the email message, and automatically managing an e-mail message dialog with the source to resolve the issue(Fig 6/21/22/23).

12. As per claim 7, Gifford teaches the method of claim 6 in which at least some of the e-mail dialog is performed automatically(col 5 lines 53-57).

13. As per claim 8 Gifford teaches software guided interactive e-mail message dialogs to resolve, on behalf of a vendor, customer issues that occur in direct response e-mails messages that are automatically identified as requiring a dialog(col 5 lines 29-44)(Fig 4/8/9/10/11/12/13/14).

14. As per claim 9 Gifford teaches a machine-based method comprising automatically sorting e-mail messages, based on response information contained in the messages, into e-mail messages that can be processed automatically to generate commercial transactions(Fig 4/15), e-mail messages in which the response information is inadequate to permit generation of commercial transactions(Fig 4/14/8/9/10/11/12/13), and e-mail messages that may be subjected to exception handling to yield information that is sufficient to generate commercial transactions(Fig 4/17).

15.(AMENDED) As per claim 10, Gifford teaches a machine-based method comprising analyzing an e-mail message to derive response information concerning a commercial transaction(Fig 1/68/64/66/67/62/200), and in response to the e-mail message, automatically generating a confirmatory e-mail message to the source of the e-mail message confirming that the commercial transaction has been or will be completed(col 5 lines 49-60).

16.(AMENDED) As per claim 11 Gifford teaches a machine-based method comprising receiving inbound e-mail messages that result from corresponding outbound e-mail messages associated

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with a marketing program(col 4 lines 48-50), the inbound messages containing response information, and each of the outbound e-mail messages being associated with a distinct piece of the marketing program(col 5 lines 21-22)(Fig 3), and automatically associating the response information in each of the inbound messages with the corresponding distinct piece of the marketing program(Fig 3/3)(col 5 lines 22-27).

17. As per claim 12 Gifford teaches the method of claim 11 in which the piece comprises a marketing campaign or a marketing flight(col 4 lines 53-56)(Fig 1/65/66).

18. As per claim 13 Gifford teaches the method of claim 11 in which the inbound messages contain information that links them to the corresponding outbound messages, and the associating step uses the link information(col 5 lines 18-22)(Fig 3/3)(Fig 2/1/2/3).

19. As per claim 14 Gifford teaches the method of claim 13 further comprising automatically parsing the inbound messages for order information(col 5 lines 22-col 6 line 2)(Fig 6/19/20/21/22/23/24/25).

20. As per claim 15 Gifford teaches a machine-based method comprising sending outbound e-mail messages associated with commercial transactions(Fig 5)(col 5 lines 45-48), storing information related to each of the outbound messages in a database, the information being useful for completing the commercial transactions(col 6 lines 15-31), the information not being contained in the outbound messages, analyzing inbound e-mail messages that result from the outbound messages and that contain response information useful in completing the commercial transactions

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(col 5 lines 49-59)(Fig 6/19/20), and automatically merging the response information with corresponding information in the database for use in completing the transactions(Fig 6/21/22/23).

21. As per claim 16 Gifford teaches a machine-based method comprising sending outbound e-mail messages associated with commercial transactions(col 6 lines 20-29), storing information related to each of the outbound messages in a database(col 6 lines 39-42), the information being useful for completing the commercial transactions, the information not being contained in the outbound messages(col 5 lines 18-19)(Fig 3/3), analyzing inbound e-mail messages that result from the outbound messages and that contain response information useful in completing the commercial transactions(Fig 1/68/64/66/67/62/200), identifying inbound e-mail messages that cannot be processed automatically to generate the commercial transactions(Fig 4/14/8/9/10/11/12/13), and using the database information to assist in exception handling of the identified inbound messages(col 5 lines 29-32)(Fig 4/17).

Response to Arguments

22. Applicant's arguments filed 4/3/01 have been fully considered but they are not persuasive. Gifford teaches a system for the purchasing of goods over a computer network. Merchant computers on the network maintain databases of digital advertisements accessed by buyer computers(Abstract). In response to user inquiries buyer computers(Fig 1/61/62/67) retrieve and display digital advertisements from merchant computers(Abstract). Indeed, in any case, as an alternative, e-mail may be used to send confirmation messages between a user and the payment system(col 11 lines 19-21); this is indeed an option designated in the Gifford invention. This is

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precisely what Applicant's system implements, namely the use of e-mail messages, as stated in his "Remarks". It is unlikely that a computer networking system employing digital advertisements and URLs would only utilize a "mail order system that is electronic" as suggested by applicant. This would be technologically mismatched. Indeed, Gifford (Fig 6/29/30/31) addresses a conformation means implementing an electronic mail order system (col 7 lines 8-10). Applicant's invention lacks novelty and inventiveness.

Conclusion

23. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Questions regarding this communication should be directed to the examiner, Dr. Geoffrey Akers, P.E. who can be telephoned at (703)-306-5844 between the hours of 6:30 AM and 5:00 PM Monday through Friday. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Vincent Millin, SPE, may be contacted at (703)-308-1065. GRA/4/25/01



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